REMARKS

This application was filed with 11 claims. Claims 1, 2, 6, and 11 have been rejected. Claims 3-5 have been objected to as depending from a rejected claim. Claim 3 has been amended to incorporate the limitations of the claims from which it depends, thus obviating the objections to claims 3-5. Claims 1 and 11 have been amended. Claims 7-10 have been allowed. New claims 12-19 have been added. Therefore, claims 1-19 are pending in the application. Claims 12 and 19 are independent claims; payment of One Hundred Fifty-Six and No/100 Dollars ($156.00) for two (2) independent claims in excess of three (3) is included herewith. Reconsideration of the application based on the proposed amended claims and specification, and arguments submitted below, is respectfully requested.

Amendments To Specification

In response to Examiner's request to update status of related applications and non-entry of prior amendments to the specification due to lack of correspondence between the specification and the amendments, Applicant is submitting a substitute specification pursuant to 37 C.F.R. §1.125 (a). A marked-up copy of the specification and a statement of no new matter is enclosed.

Claim Rejections - 35 U.S.C. §102(e)

Claims 1, 2, 6, and 11 have been rejected under 35 U.S.C. §102(e) as being anticipated by *Evans, et al.* (US 4,825,200).

Claims 1 and 11, as amended, are patentable over *Evans* because *Evans* does not disclose each element of Claims 1 and 11. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant has amended the claims to more particularly point out the limitation for a "reassignment means." The prior art does not disclose a "reassignment means." Applicant's reassignment means provides the capability to reassign data already stored in memory to different keys. Prior art *Evans* discloses means for reading in data external to the remote to different keys. The prior art does disclose a "preset key" sequence to execute a lengthy key sequence with fewer keystrokes. The data, however, is still associated with the same key sequence; the "same key sequence" may be executed via a "preset key." As will be discussed in more detail below, *Evans* requires re-entry of data to change key assignments.

Claims 2 and 6 are patentable over *Evans* because they incorporate the patentable limitations of Claim 1. For expediency, the independent patentability of Claims 2 and 6 are not discussed.

Accordingly, Applicant respectfully submits that the rejection of Claims 1, 2, 6, and 11 under 35 U.S.C. §102(b) should be withdrawn and, therefore, so requests.

Claim Are Non-Obvious Over Prior Art Of Record

While no claims have been rejected under 35 U.S.C. §103(a), Applicant respectfully asserts that rejected Claims 1, 2, 6, and 11, and newly submitted claims 12-19, are non-obvious in light of

the prior art in addition to not being anticipated by the prior art. As discussed in the above Section, the prior art does not teach the claimed invention. To establish a *prima facie* case of obviousness, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Because the prior art does not teach a "reassignment means" as claimed, the Applicant respectfully submits that the Examiner has not made out a *prima facie* case of obviousness.

In fact, *Evans* teaches away from Applicant's claimed invention. *Evans* teaches that the "user has complete discretion in determining the function to be performed by each key." *Evans*, Column 7, lines 40-42. However, *Evan*'s "complete discretion" is accomplished via a delete-re-entry process, rather than a reassignment means. "If at any time while entering codes for a device into [the remote] controller, the [*Evan's*] user decides that he wishes to use a different key for the particular function than the key he has previously designated for such function, he may operate [the] delete key followed by the key for such function. This will cause the entry in RAM for such function to be deleted." *Evans*, Column 7, lines 50-57. (Emphasis added.) *Evans* then requires that the function "be re-entered in the system in the manner [discussed in *Evans*] and stored in conjunction with the new key." *Evans*, Column 7, lines 58-60. Applicant's "reassignment means" allows data already stored in memory to be reassigned to a new key (or assigned to a key if it was not already). The amended claims more clearly define and point out the "reassignment means." Accordingly, Applicant's invention as defined by the claims is patentable over the prior art of record.

Objected To Claims

Claims 3-5 were objected to as depending from a rejected base claim, but otherwise allowable. Claim 3 has been written in independent form, including all the limitations of Claims 1 and 2 (as previously amended). Thus, Claim 3 should be allowable. Claims 4 and 5 depend from Claim 3, a now allowable claim, and as such, are themselves allowable.

Allowed Subject Matter

Allowance of Claims 7-10 is acknowledged. Applicant respectfully submits that *Evans* '200 merely assigns data to keys by re-entry of data (*Evans*, Column 7, lines 50-60, emphasis added.), rather than reassign data to a different key.

Conclusion

For the aforementioned reasons, Applicant respectfully requests the withdrawal of the rejections of the claims under 35 U.S.C. §102(e). Applicant respectfully submits that Claims 1, 2, 6, and 11, as amended, and new claims 12-19 are patentable over the prior art of reference for the aforementioned reasons. Thus, Applicant respectfully requests reconsideration of the instant application.

Please charge any additional fees or credit any overpayments associated with the filing of this correspondence to Deposit Account No. 011,056.

Please call the undersigned attorney, if there are any further questions prior to examination.

Respectfully submitted,

By: _____

Mark R. Galis, Reg. No. 36,805
Altheimer & Gray
10 South Wacker Drive, Suite 4000
Chicago, Illinois 60606-7482
(312) 715-4770

Certificate Under 37 C.F.R. 1.8: The undersigned hereby certifies that this Reply and Amendment/Petition, including enclosures, are being deposited in the United States Postal Service, via First Class Mail, in an envelope addressed to: BOX-FEE, Honorable Assistant Commissioner of Patents, Washington D.C. 20231, on this 23 day of March, 1999.

By: _____ 3/23/99

Name: Mark R. Galis **DATE**